

REMARKS

1. The Office Action of November 7, 2005 is hereby acknowledged. The shortened statutory period of three (3) months time period for response to this Office Action expired on February 7, 2006. Concurrently with the filing of this Amendment, the Applicant has requested a three-month extension of time and has paid the appropriate fee. Therefore, the deadline for filing the response is May 7, 2006. This Amendment Under 37 C.F.R. § 1.111 is being mailed by Express Mail, Mail Label No. EV 593954111 US, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on April 21, 2006. Therefore, this amendment this Amendment is timely filed. In the event that the Commissioner for Patents should determine that any additional extension of time is required for this Amendment to be timely filed and an appropriate fee is due for that extension of time, then the Commissioner for Patents is hereby authorized to charge Deposit Account Number 18-2222 for such appropriate fee.

2. In the '332 Application, Claim 1 has been amended. No claims have been cancelled and no claims have been added. The original '332 Application contained 16 total claims wherein two were independent claims. The '332 Application still has 16 total claims wherein two are independent claims. Therefore, it is believed that no additional fee is due. In the event that the Commissioner for Patents should determine that any additional fee is due, then the Commissioner for Patents is hereby authorized to charge Deposit Account Number 18-2222 for the appropriate fee.

3. The Applicant will address each of the Examiner's statements as set forth in the Office Action.

3.01 Claims 1-5 Rejection - 35 USC § 102

The principal difference between the present Application and Schlauch is that the present Application teaches a tamper-evident transparent housing which surrounds the memorabilia article. Additionally, a biological marker is placed on the tamper-evident housing to further ensure authentication.

[Office Action] *Regarding claim 1 - Schlauch discloses a system comprising: a housing, the housing having front and rear portions, the front and rear portions including mirror-image indentations, the indentations defining receptacles when the housing portions are mated together (Col 12, 25, 26, 36; Claims 1 -5, 9-11, 111; surface area of base article, and another surface area adjacent and outside of that surface area; affixed surfaces, observe and reverse sides of the surface are; unified body of tangible material; Packaged memorabilia, Col 12, items 101, 102; Col 14, item 910; Col 16, items 2240, 2245, 2246, 2247; masking removably attached to base article); a memorabilia article disposed in first one of the receptacles (Col 1 2, 1 3; items 1 93, 293, 393: pictorial image; Fig 2A, 2B, 3A, 3B, 4A, 4B, 11A; memorabilia article; Claim 1, base article); an identification tag disposed in a second one of the receptacles, the identification tag including an authenticated autograph of a unique individual associated with the memorabilia article (Col 25, Claim 5, authentication statement, Col 26, Claim 9, autograph of preferred personality; Fig 1A, element 130.*

In the '332 Application Claim 1 as now amended reads:

" An authenticated memorabilia system, the system comprising:

1 a housing, the housing having front and rear portions, the front and rear portions
2 including mirror-image indentations, the indentations defining receptacles when the housing
3 portions are mated together;

4
5 a memorabilia article disposed in first one of the receptacles;

6
7 an identification tag disposed in a second one of the receptacles, the identification tag
8 including an authenticated autograph of a unique individual associated with the memorabilia
9 article;

10
11 the front and rear housing portions are constructed of a substantially transparent
12 material such that a front and rear surface of the memorabilia article and a front and rear
13 surface of the identification tag are visible through the front and rear housing portions; and
14 the memorabilia article and the identification tag are encapsulated in the transparent
15 housing at an encapsulation facility under the supervision of an authentication service and the
16 housing permanently sealed along a periphery such that neither the memorabilia article nor
17 the identification tag may be removed therefrom without providing visual indications of
18 tampering on the housing.
19

20
21 The above Claim 1 has now been amended to include the features of the last element.
22 There is full support in the patent specification in the last four lines of Item 0009 supporting
23 this addition. Therefore, no new matter has been added.

24
25 Applicant agrees that Schlauch discloses an authenticated memorabilia system, but
26 respectfully disagrees that it covers amended Claim 1 of the '332 Application.. The Office
27 Action cites to Col 12, 25, 26 and 36. Neither deal with a tamper-evident transparent housing.
28 Col. 25 speaks of a "removable" mask which is temporarily used when placing a fingerprint

1 on the item (Col. 25:44-45), but nothing that intimates a tamper-evident transparent housing.

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3
4 Schlauch Claims 1-3 deal with affixing a fingerprint to the article, 4 with affixing a limited
5 edition marking and 5 with affixing a notarized statement of authenticity.

6
7 Schlauch Claims 9 – 11 deal with adding to the memorabilia article a fingerprint and
8 autograph and a picture in combination along with the limited edition marking.

9
10 Schlauch Claim 111 deals with a packaging material for the article.

11
12 Nowhere does it state that the packaging material is a transparent plastic material, which then
13 forms an enclosure around the memorabilia article when mated.

14
15 What distinguishes Claim 1 of the '332 Application from Schlauch is that the in the
16 present application “the front and rear housing portions are constructed of a substantially
17 transparent material” which are then “mated” together. Nowhere does Schlauch disclose a
18 housing made of a transparent material which is then mated together.

19
20 The Office Action cites to Schlauch (Col 9, lines 5-25, clear surface; Col 11 , lines 5-
21 50; Figures 1A, 1B, 2A, 2B; viewable observe and reverse sides; Col 35- 37 Claims 105, 111,
22 119, plastic material) for the premise that Schlauch teaches a transparent material

23
24 The “plastic” referred to in claim 105 is the memorabilia item, and not the transparent
25 housing that is formed around the memorabilia item.

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27
28 Col 9, lines 5-25, clear surface;

1 Col 9, lines 5-25 states:
2

3 The base article may have a defined and prepared surface area created for affixing at
4 least one preferred-personality-created integral collectible attractiveness attribute
5 and/or other specific integral collectible attractiveness attributes. The defined and
6 prepared surface area may be constructed to more readily allow clearer and better
7 affixing of one or more attributes to the base article with intent to make the article
8 more attractive to memorabilia collectors.
9

10
11 Thus the word "clearer" is used as "clearer and better", and not "clear" in the sense of
12 transparent as used in the phrase "transparent housing". The word "transparent" as used in
13 the '332 Application means "see-through".
14

15 While Schlauch discloses a "base" to hold the memorabilia item, it does not speak of a
16 tamper-evident transparent housing into which to place the item which is then mated.
17

18 This novel method disclosed in Claim 1 for guaranteeing authenticity should be
19 sufficient to overcome the stated objections.
20

21 [Office Action] *Regarding claim 2, it is rejected applying as above rejecting claim 1 ,*
22 *furthermore, Schlauch discloses the memorabilia system, wherein the housing portions are*
23 *constructed of a clear thermoplastic material which does not offer any impairment to*
24 *visualization of either the memorabilia article or the identification tag (Col 9, lines 5-25,*
25 *clear surface; Col 11 , lines 5-50; Figures IA, I B, 2A, 2B; viewable observe and reverse*
26 *sides; Col 35-37 Claims 105,111, 119, plastic material).*
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1 The "plastic material " of Claims 105,111, 119 or 105 is actually a "plastic item" and
2 is the (plastic) memorabilia article itself, and not the sealed housing surrounding the "plastic"
3 item. As discussed above, the phrase "clear surface" of the Office Action is actually "clearer
4 and better", and not "clear" in the sense of transparent as used in the phrase "transparent
5 housing". The word "transparent" as used in the '332 Application means "see-through".
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7
8 Schlauch does not teach that the "housing portions are constructed of a clear
9 thermoplastic material".
10

11 The novel use of a tamper-evident thermoplastic material for guaranteeing authenticity
12 should be sufficient to overcome the stated objections.
13

14 [Office Action] *Regarding claim 3, it is rejected applying as above rejecting claim 2,*
15 *furthermore, Schlauch discloses the memorabilia system, wherein both surfaces of the*
16 *identification tag containing identification and authentication indicia, the front face of the*
17 *identification tag including text which identifies the issuing entity and text identifying the*
18 *memorabilia article contained within the receptacle (Fig IA, IB, elements 100, 120: viewable*
19 *texts in observe and reverse sides, element 140: fingerprint, element 120: information about*
20 *fingerprints; Fig 4A, 4B, element 440: fingerprint in observe side, elements 450, 460, 480:*
21 *autograph, authenticating text in reverse side; Col 25-27, claims 1-15, authentication*
22 *statement, genuine autograph, and fingerprint of preferred personality; Col 36, Claim 111 ,*
23 *numeric and text indicium).*
24
25

26 While Schlauch does teach using signature, fingerprints and an authentication
27 statement as indicia for authentication, what makes the '332 Application distinguishable is
28

1 that it combines these previous methods of authentication known in the art with a tamper-
2 evident transparent housing, giving the signature, fingerprints and an authentication statement
3 greater authenticity and value. Further, any signature, fingerprints and an authentication
4 statement can appear on the identification tag of the present application and not on the
5 memorabilia item, which prevents associated degradation of the memorabilia item. These
6 novel features and improvements should be sufficient to overcome the stated objections.
7

8
9 [Office Action] *Regarding claim 4, it is rejected applying as above rejecting claim 3,*
10 *furthermore, Schlauch discloses the memorabilia system, wherein a portion of the front face*
11 *of the identification tag includes an area reserved for a grading mark, the grading mark*
12 *providing an indication of a collectable condition designation of the memorabilia article, the*
13 *identification tag further including a numerical designator indicating the quality degree*
14 *within a particular condition designation (Col 27, Claim 13; Fig IA, IB, 2A, 2B; LIMITED*
15 *EDITION, LIMITED SERIES markings; elements: 200, 220: Card number, series number,*
16 *number of copies, edition etc; Col 36, Claim III, numeric and text indicium).*
17

18
19 While Schlauch does teach using grading mark, what makes the '332 Application
20 distinguishable is that it combines the grading mark known in the art with a tamper-evident
21 transparent housing, giving the grading mark greater authenticity and value. Further, any
22 grading mark can appear on the identification tag as described in the '332 Application and not
23 on the memorabilia item, which prevents associated degradation of the memorabilia item.
24 These novel features and improvements should be sufficient to overcome the stated
25 objections.
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[Office Action] *Regarding claim 5, it is rejected applying as above rejecting claim 4, furthermore, Schlauch discloses the memorabilia system, wherein the identification tag further includes a serial number, the serial number comprising a unique alpha or alpha numeric sequence which specifically identifies the memorabilia article disposed within the housing (Col 36, Claim 111, numeric and text indicium, unique number).*

While other patents teach using a unique serial number, Schlauch teaches using one that uniquely identifies a given item by a series of increasing edition numbers for that item. The '332 Application is distinguishable as a result of the combination of the unique serial number with the tamper-evident transparent housing, giving the unique serial number greater reliability and value. Further, any unique serial number can appear on the identification tag of the present application and not on the memorabilia item, which prevents associated degradation of the memorabilia item. These novel features and improvements should be sufficient to overcome the stated objections.

3.02 Claim Rejections - 35 USC § 103

[Office Action] *Regarding claim 6, it is rejected applying as above rejecting claim 5, furthermore, Schlauch discloses the memorabilia system according to claim 5, the identification tag further including: a marker area (Fig 1A, 1B, item 140, fingerprint; Col 29, Claim 43; Col 30, claim 54; fingerprint; Col 32; Claim 68, fingerprint; Fig I 2A; Col 11 lines 15-27, fingerprint area). Schlauch further disclose a biological marker to be used in memorabilia article (Fig 1A, 1B, item 140, fingerprint; Col 29, Claim 43; Col 30, claim 54; fingerprint; Col 32; Claim 68, fingerprint; Fig I 2A; Col 11, lines 15-27, fingerprint area). Schlauch does not expressly disclose that the biological marker invisible to the naked eye and*

1 only visible under light in specific wavelengths, the presence of the biological marker
2 providing an indication of authenticity of the memorabilia article. However, Soules et al
3 discloses a biological marker invisible to the naked eye and only visible under light in
4 specific wavelengths, the presence of the biological marker providing an indication of
5 authenticity. Fig 1 element 16; Col 3, lines 50-55; fingerprint; Col 12, Claim 1, indicia
6 (barcode) is visible only in specific wavelength, and readable by machine. At the time of
7 invention, it would be obvious to an ordinary skill in the art to use similar technique to design
8 a memorabilia comprising a biological mark which is only visible through specific
9 wavelength). At the time of invention, it will be obvious to a person with ordinary skill in the
10 art to combine the teachings of Soules et al with Schlauch to design a memorabilia containing
11 a biological security marking which is invisible in naked eyes, but visible in lights in different
12 wavelength. Motivation for doing so would have been that such human invisible biological
13 security markings are commonly used in the security articles for authentication purposes, or
14 to provide a tamper-proof mechanism for security articles Ccl 1 1, lines 5-1 1).

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18 A fingerprint is not considered a biological marker, as understood in the art. A
19 biological marker typically considered to be some type of dye that attaches to a cell and then
20 the location of the cell can be seen by illuminating it with a specific wavelength of light. The
21 fingerprint is made of a standard visible chemical ink. Standard ink is not considered a
22 biological material in the art. The premise that Schlauch teaches a biological marker area is
23 not reasonably included in the disclosing art. That being the case, the premise that the
24 combination of the teachings of Schlauch in light of Soules et al. bars the present Application
25 is not plausible.
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1 A second basis shows that the teachings of Schlauch in light of Soules et al. bars the
2 present Application. The Office Action takes the position that the teachings of Schlauch in
3 light of Soules et al. bars the present Application because it states that Schlauch teaches the
4 use of a transparent thermoplastic housing, which it does not reasonably do. That being the
5 case, the teachings of Soules to be applicable, require a novel tamper-evident transparent
6 thermoplastic housing to encase the memorabilia article.
7

8
9 A third basis also prevents Schlauch in light of Soules from denying the application
10 based on 103. The present application is a classic case of hindsight.
11

12 Only after the use of a tamper-evident transparent thermoplastic housing is disclosed
13 in the present art are the teachings of Soules applicable. In other words, it is not until after
14 the present invention adds a novel tamper-evident transparent thermoplastic housing to encase
15 the memorabilia article that the teachings of Soules become obvious.
16

17 The genius of invention is often a combination of known elements that in hindsight
18 seems preordained Medtronic, Inc. v. Daig Corp., 611 F. Supp. 1498, 1534, 227 USPQ 509,
19 535 (D. Minn. 1985), aff'd, 789 F.2d 903, 229 USPQ 664 (Fed. Cir. 1986), cert. denied, 479
20 U.S. 931 (1986) ("Hindsight ... is quite improper when resolving the question of obviousness.
21 To use the patent in suit as a guide through the morass of prior art references, combining the
22 right references in the right way to arrive at the result of the claims in suit is ... also quite
23 improper.").

24
25 "The existence of an enduring, unmet need is strong evidence that the invention is
26 novel, not obvious, and not anticipated. If people are clamoring for a solution, and the best
27 minds do not find it for years, that is practical evidence the kind that can't be bought from a
28

1 hired expert, the kind that does not depend on fallible memories or doubtful inferences__of
2 the state of knowledge." ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546, 48 USPQ2d 1321,
3 1329 (Fed. Cir. 1998) ("Determination of obviousness can not be based on the hindsight
4 combination of components selectively culled from the prior art to fit the parameters of the
5 patented invention."
6

7 The present application is not the combination of the teachings of Schlauch and
8 Soules because it adds a tamper-evident transparent thermoplastic housing which is not taught
9 by either and thus can not be barred by a combination of Schlauch and Soules.
10

11 [Office Action] *Regarding claim 8, it recites limitations of claim 1 , therefore it is rejected*
12 *applying as above rejecting claim 1 . Furthermore, DiCesare et al discloses a method for*
13 *authenticating a memorabilia article, the method comprising: the autograph being inscribed*
14 *on the tag in the presence of an agent of a recognized authentication service (Col 5, Claim 1 ,*
15 *representative of authentication service); encapsulating the memorabilia article and the*
16 *identification tag in a housing within an encapsulation facility under the supervision of the*
17 *authentication service (Col 5, Claim I , representative of authentication service; witnessing*
18 *autographing); and permanently sealing the housing along a periphery, such that neither the*
19 *article nor the tag may be removed therefrom without providing visible indications of*
20 *tampering on the housing (Col 5-6, Claim I , representative of authentication service,*
21 *witnessing the autographing; Col 5, lines 1 5-21 , affixed the article with tamperproof*
22 *adhesive). At the time of invention, it will be obvious to a person with ordinary skill in the art*
23 *to combine the teachings of DiCesare et al with Schlauch to design a memorabilia system*
24 *further comprising an authentication services providing authentication supervision.*
25 *Motivation for doing so would have been simply to provide consumers with tamperproof*
26
27
28

1 *authenticated memorabilia (DiCesare et al, Col 5, lines 3-22), or to ensure greater article*
2 *security (DiCesare, Col 2, lines 31-36).*

3
4 The present application has advantages over DiCesare et al in that it allows for
5 authentication using an authentication service yet does not require any adhesives and the like
6 to come in contact with the memorabilia item. This is also made possible by the novel use of
7 a tamper-evident transparent thermoplastic housing not taught in the prior art. The present
8 invention adds greater overall authenticity to memorabilia item and by use of the novel use of
9 a tamper-evident transparent thermoplastic housing. For these reasons Schlauch in light of
10 DiCesare likewise can not serve as a bar to the present application.
11

12
13 [Office Action] *Regarding claim 7, it is rejected applying as above rejecting claim 5,*
14 *furthermore, although Schlauch discloses a visual authentication for the memorabilia system*
15 *(Col 25, Claim 5), and the unique number associated with such memorabilia (Col 36, Claim I*
16 *II, numeric and text indicium, unique number), Schlauch does not expressly discloses a*
17 *memorabilia system further comprising an authentication service, a memorabilia article*
18 *registration database, maintained by the authentication service; and wherein the unique*
19 *serial number is associated to the specific memorabilia article in the database. However,*
20 *DiCesare et al discloses a memorabilia system further comprising an authentication service*
21 *(Col 3, lines 4- 35; a certificate of authenticity; Col 5-6, lines I 0-20, Claim I, authentication*
22 *company! system), a memorabilia article registration database, maintained by the*
23 *authentication service (Col 3, lines 4- 35; a certificate of authenticity, database containing*
24 *certificate of authenticity, an identifying code associated with each article; Col 5-6, lines I 0-*
25 *20, Claim I, authentication company! system); and wherein the unique serial number is*
26 *associated to the specific memorabilia article in the database (Col 3, lines 4- 35; a certificate*
27
28

1 of authenticity, database containing certificate of authenticity, and unique identifying code
2 associated with each article).

3
4 The present application does take advantages of the teachings of DiCesare et al. in
5 using a unique identifying number. However, that number, has greater reliability when
6 placed on an identifier tag housed in a tamper-evident transparent thermoplastic housing. The
7 present invention thus adds greater overall authenticity to memorabilia item and unique
8 numbering. Further, the unique number does not appear on the item, which causes
9 degradation of the item in the previous art.
10

11
12 The remainder of the Office Action rejections should be overcome by the above.

13
14 4. Therefore, it is respectfully submitted that the present invention with the claims as
15 now amended is in condition for allowance and issuance of a Notice of Allowance is
16 respectfully solicited.

17
18 Date: Apr. 1 21, 2006

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